

REMARKS REGARDING RESPONSES AND AMENDMENTS**1. Amendment of Drawings**

Corrected Drawings have been submitted with this Response.

2. Response to the Specification

The Specification has been amended at the Brief Description of the Drawings.

3. Response to Rejections under 35 USC 102(b)

The Examiner has rejected claims 1-3 as anticipated by Boult, under 35 U.S.C. 102(b)..

Regarding the Examiner's rejection of Claim 1, your applicant respectfully draws the Examiner's attention to the structure of the present invention. The present invention comprises a primary shaft (10) joined at a second end (30) to a lure shaft (40) at a lure shaft second end (60). A hook means (70) is affixed at the primary shaft second end (30). This structure is distinguished from that of Boult. The Examiner's attention is drawn to Boult where a hook means is affixed at the equivalent of the lure shaft first end (50) of the present invention. This is in opposition of the placement of the hook means (70) in the present invention at the lure shaft second end (60) and the primary shaft second end (30) of the present invention.

Additionally, the Boult tube (28), which is the analog of the lure shaft (40) of the present invention, is not received and locked at a locking means (110) as seen in your applicants invention.

Your applicant has amended the Drawings and has submitted substitute Drawings. However, the structural differences between your applicant's invention and that of Boult is seen in the comparison of the Figures as originally submitted with this application.

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No. 10/654,854 on June 3, 2004 by
Floyd E. Ivey in response to Office Action
of March 3, 2004.

1 It is respectfully submitted that said differences distinguish your applicant's
2 invention from that of Boultt et al. Your applicant has amended claims. Your applicant
3 respectfully requests the Examiner to withdraw the rejection under 35 U.S.C. 102(b).

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5 Regarding the Examiner's rejection of Claim 2, the Examiner compares that
6 portion of Boultt between "26 and 22" with the "shaft interconnection means ...by
7 welding, wire wrap, wire twist, or ferrule" of the primary shaft at the second end (30)
8 with the lure shaft second end (60). Your applicant respectfully draws the Examiner's
9 attention to the structure of Boultt at the "26 to 22" portion where a single wire is bent at
10 22 of Boultt thereby forming a first arm 24 and a second arm 26. (Boultt at col 4/lines
11 22-23. Your applicant respectfully argues that this forming of a "...substantially V-shape
12 at an apex...", seen in Boultt at col 4/line 22, is not the structure described by your
13 applicant in joining the primary shaft and the lure shaft.

14 The Examiner, at paragraph 4, last phrase, refers to "lure shaft locking means is
15 by ferrule means (40)" for Boultt. The Examiner's attention is drawn to Boultt col 5/lines
16 26-28 and the identification of hollow sleeve (40). The Examiner will see that the hollow
17 sleeve (40) of Boultt is at the equivalent of the first end (20) of the primary shaft (10) of
18 your applicant's invention rather than at the lure shaft first end (50). That is, the hollow
19 sleeve (40) of Boultt secures the "primary shaft" or second arm (26) of Boultt rather than
20 the lure shaft.

21 It is respectfully submitted that said differences distinguish your applicant's
22 invention from that of Boultt et al. Your applicant has amended claims. Your applicant
23 respectfully requests the Examiner to withdraw the rejection under 35 U.S.C. 102(b).

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25 Regarding the Examiner's rejection of Claim 3, the Examiner again observes "the

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1 shaft interconnection means is by wire twist of the lure shaft 22 proximal the lure shaft
2 second end about the primary shaft proximal the second end" with reference to elements
3 20, 22 of Boultt in Fig. 8. The Examiner's attention is directed to the continuous wire
4 shaft of Boultt extending to form the first leg 24 and the second leg 26 with a V-shape
5 apex formed at the bend 22. There is no comparable structure in Boultt to the primary
6 shaft (10) and the lure shaft (40) and the interconnection of the two as is seen in your
7 applicant's invention. Reference is here made to the arguments set forth relative to the
8 above rejections of Claims 1 and 2.

9 The Examiner refers to a double barrel ferrule 40 in Boultt. Your applicant refers
10 the Examiner to Boultt at column 5/lines 26-27 where the element indicated as a double
11 barrel ferrule 40 in Boultt is stated as "...a hollow cylinder 50 illustrated by itself in GIG.
12 6." Thus your applicant respectfully asserts that Boultt does not depict or claim a double
13 barrel ferrule.

14 The Examiner observes, in Boultt, the use of a ferrule 28 having a first ferrule end
15 and a second ferrule end with the second ferrule end receiving the hook shaft. The
16 Examiner is respectfully directed to Boultt at col 4/line 21-23 where the "wire shaft 20
17 angularly bent into a substantially V-shape at an apex 22 forming a first arm 24 and a
18 second arm 26. And the Examiner is directed to col 4/line 33-34 stating "The prime
19 novelty of the invention [of Boultt] resides in the addition of a hollow tube 28 positioned
20 over and intimately surrounding the shaft first arm 24. This tube 28 reinforces..." Hence,
21 there is no ferrule 28 in Boultt. Rather, in Boultt, col 5/lines 30-33, "A conventional
22 fishing hook 42 is angularly crimped onto the outermost end of the first arm 24 and tube
23 28, as depicted in the cross-section of FIG. 8 ..." Your applicant respectfully observes
24 that there is no ferrule interconnection between a shaft and a hook.

25 It is respectfully submitted that said differences distinguish your applicant's
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1 invention from that of Boultt et al. Your applicant respectfully requests the Examiner to
2 withdraw the rejection under 35 U.S.C. 102(b).

3
4 **4. Response to Rejections under 35 U.S.C. 103(a)**

5 The Examiner, at paragraph 7 rejects Claims 4 and 5 under 35 U.S.C. 103(a) in
6 light of Boultt in view of Ogle. The Examiner notes that Boultt discloses a metal wire
7 with a spring function at col 4/lines 22-25. The Examiner is referred to Boultt claim5
8 regarding a "spring" function in Boultt. The reference at col 4/lines 22-25 to "spring" is
9 to the preferred material for the forming of the continuous wire comprising the first arm
10 and second arm, 24 and 26, but does not then describe a spring function between the first
11 arm and the second arm, 24 and 26.

12 This is distinctly different structure from that described by your applicant at the
13 patent application page 4 commencing at line 14 where the lure shaft (40) is urged away
14 from the primary shaft (10) by a spring function when the lure shaft (40) is received into
15 the second barrel (130). Claim 4 of this application has been amended to state said spring
16 function with the lure shaft is received into the second barrel.

17 The Examiner notes that copper wire is an obvious choice. Your applicant has
18 stricken the reference to "...copper or..." in claim 4.

19 At paragraph 12 the Examiner rejects claim 5 and notes beads disclosed by Boultt
20 and the use of spinners. Claim 5 has been cancelled.

21
22 **Law regarding 35 U.S.C. 102.**

23 A rejection for anticipation under section 102 requires that each and every
24 limitation of the claimed invention be disclosed in a single prior art reference. (*In Re*
25 *Paulsen*, 30 F.3d 1475, 1478-79, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994); For a prior art
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1 reference to anticipate in terms of 35 U.S.C. S 102, every element of the claimed
2 invention must be identically shown in a single reference. The elements must be arranged
3 as in the claim under review. (*In Re Bond*, 910 F.2d 831, 832, 15 USPQ2d 1566, 1567
4 (Fed. Cir. 1990). Prior art anticipates an invention ... if a single prior art reference
5 contains each and every element of the patent at issue, operating in the same fashion to
6 perform the identical function as the patented product. "Thus, any degree of physical
7 difference between the patented product and the prior art, NO MATTER HOW SLIGHT,
8 defeats the claim of anticipation." (*American Permahedge, Inc. v. Barcana, Inc.*, 857 F.
9 Supp. 308, 32 USPQ2d 1801, 1807-08 (S.D. N.Y. 1994); It is incumbent upon the
10 examiner to identify wherein each and every facet of the claimed invention is disclosed in
11 the applied reference. (*Ex Parte Levy*, 17 USPQ2d 1461, 1462 (Bd. Pat. App. & Int'f
12 1990)). Since the structures of Boulit differ from that shown herein, the reference must
13 be discounted as anticipating the present invention.

14 The applicant has demonstrated differences between features of the referenced
15 prior art and the present invention as specified and claimed. The applicant has presented
16 features of the present invention which are not found within the claims of either reference
17 patent. The applicant has presented law and argument to support the contention that the
18 rejection of claims 1- 3, under 35 U.S.C. 102(b) should be withdrawn and now
19 respectfully requests the Examiner to withdraw the rejections.

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21 Law regarding 35 U.S.C. 103.

22 The absence of a feature similar to the feature or features of the present invention
23 are respectfully argued as references which teach away from the disclosed and claimed
24 invention and thus are not appropriately a basis of rejection under 103. *In re Gurley* 27
25 F.3d 551 at 553(1994 cafc). In general a reference will teach away if the line of
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1 development flowing from the references disclosure is unlikely to be productive of the
2 result sought by the applicant. The lack of a spring function in Boulit does not flow
3 toward the spring function between the primary shaft and the lure shaft of the present
4 invention.

5 The Examiner has urged prior art alone and in combination as rendering obvious
6 the present invention. However, there is not demonstrated teaching, suggestion or
7 motivation to so combine the several components in the manner done by your present
8 applicant. Such recitation of prior art does not form a basis for rejection as obvious. C.R.
9 Bard, Inc. v. M3 Systems, Inc., 157 F.3d 1340, 1361, 48 USPQ2d 1225, 1240 (Fed. Cir.
10 1998), rehearing denied & suggestion for rehearing in banc declined, 161 F.3d 1380 (Fed.
11 Cir. 1998) ("The ultimate question is whether, from the evidence of the prior art and the
12 knowledge generally available to one of ordinary skill in the relevant art, there was in the
13 prior art an appropriate teaching, suggestion, or motivation to combine components in the
14 way that was done by the inventor."); Chiuminatta Concrete Concepts, Inc. v. Cardinal
15 Industries, Inc., 145 F.3d 1303, 1312, 46 USPQ2d 1752, 1759 (Fed. Cir. 1998) ("for a
16 claim to be invalid for obviousness over a combination of references, there must have
17 been a motivation to combine the prior art references to produce the claimed invention.");
18 Kahn v. General Motors Corp., 135 F.3d 1472, 45 USPQ2d 1608 (Fed. Cir. 1998), cert.
19 denied, 119 S. Ct. 177 (1998); Fromson v. Anitec Printing Plates, Inc., 132 F.3d 1437,
20 1447, 45 USPQ2d 1269, 1276 (Fed. Cir. 1997), cert. denied, 119 S. Ct. 56 (1998) ("there
21 is no suggestion or teaching in the prior art to select from the various known procedures
22 and combine specific steps, along with a new electrical structure, in the way that is
23 described and claimed by [the patentee]."); Gambro Lundia AB v. Baxter Healthcare
24 Corp., 110 F.3d 1573, 1578-79, 42 USPQ2d 1378, 1383, 1384 (Fed. Cir. 1997) ("the
25 record must provide a teaching, suggestion, or reason to substitute computer-controlled
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1 valves for the system of hoses in the prior art. The absence of such a suggestion to
2 combine is dispositive in an obviousness determination."; "Without a suggestion or
3 teaching to combine, [the accused infringer's] case of obviousness suffers a significant
4 deficiency."); Kolmes v. World Fibers Corp., 107 F.3d 1534, 1541, 41 USPQ2d 1829,
5 1833 (Fed. Cir. 1997) (the district court did not err in holding the patent in suit not invalid
6 for obviousness; the patent concerned a cut-resistant yarn for use in making products such
7 as gloves, which, unlike prior art yarns, did not use metallic components such as wire; the
8 yarn includes two core strands wrapped in opposite directions around two covering
9 strands; one core strand is fiberglass; the other core strand and the covering strands are
10 nylon or other material; the patent's claim required, inter alia, that there be a two strand
11 core and that the covering strands be "wrapped about said core at the rate of 8-12 turns
12 per inch."; a prior art reference showed a yarn with a wrapping rate of 2-24 turns per inch,
13 but the reference disclosed the use of wire, and the accused infringer "has shown no
14 suggestion or motivation to modify the teaching of the [reference] with regard to
15 non-metallic fibers."); Litton Systems, Inc. v. Honeywell, Inc., 87 F.3d 1559, 1568, 39
16 USPQ2d 1321, 1327 (Fed. Cir. 1996) ("[N]one of the prior art references, alone or in
17 combination, teach or suggest a method [specified in the patent's claims]. The prior art
18 simply does not contain many limitations in the claimed method. Furthermore, the record
19 discloses no teaching or suggestion to combine any of these references. The absence of a
20 suggestion to combine is telling in an obviousness determination."); B.F. Goodrich Co. v.
21 Aircraft Braking Systems Corp., 72 F.3d 1577, 37 USPQ2d 1314 (Fed. Cir. 1996),
22 discussed at N. 12.10(1) infra; Pro-Mold and Tool Co., Inc. v. Great Lakes Plastics, Inc.,
23 75 F.3d 1568, 37 USPQ2d 1626 (Fed. Cir. 1996); Beachcombers, International, Inc. v.
24 WildeWood Creative Products, Inc., 31 F.3d 1154, 1161, 31 USPQ2d 1653, 1659 (Fed.
25 Cir. 1994) (the patent claims in suit were not obvious in view of the prior art because the
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1 art did "not remotely suggest configuring" the device as required by the claim);
2 Heidelberger Druckmaschinen AG v. Hantscho Commercial Products, Inc., 21 F.3d 1068,
3 1072, 30 USPQ2d 1377, 1379 (Fed. Cir. 1993) ("When the patented invention is made
4 by combining known components to achieve a new system, the prior art must provide a
5 suggestion or motivation to make such a combination."). Texas Instruments Inc. V. U.S.
6 Int'l Trade Comm'n, 988 F.2d 1165, 26 USPQ2d 1018 (Fed. Cir. 1993) for the
7 proposition that obviousness is not supported where the references do not demonstrate to
8 combine to produce the invention as presently disclosed.

9 The issue of viewing the present invention as a template is an inappropriate basis
10 for rejection on the basis of obviousness. The prior art "references in combination do not
11 suggest the invention as a whole claimed in the ... patent. Absent such a suggestion to
12 combine the references, respondents can do no more than piece the invention together
13 using the patented invention as a template." Heidelberger Druckmaschinen AG v.
14 Hantscho Commercial Products, Inc., 21 F.3d 1068, 30 USPQ2d 1377 (Fed. Cir. 1993
15 where the court held that "The motivation to combine references can not come from the
16 invention itself."

17 The applicant respectfully submits that the references, alone and in combination,
18 otherwise must constitute improper use of hindsight reconstruction. *In Re Pleuddeman*,
19 910 F.2d 823, 828, 15 US PQ2d 1738, 1742 (Fed. Cir. 1990); *In Re Mahurkar Patent*
20 *Litigation*, 831 F.Supp. 1354, 28 US PQ2d 1801 (N.D. Ill. 1993). The cases cited stand
21 for the rule that decomposing an invention into its constituent elements, finding each
22 element in the prior art, and then claiming that it is easy to reassemble these elements into
23 the invention, is a forbidden ex post analysis. The applicant submits that it is
24 impermissible to use the claimed invention as an instruction manual or template to piece
25 together the teachings of the prior art so that the claimed invention is rendered obvious.

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1 The references simply do not teach to combine the requisite features of your applicant's
2 invention. "Before the PTO may combine the disclosures of two or more prior art
3 references in order to establish Prima Facie obviousness, there must be some suggestion
4 for doing so, found either in the references themselves or in the knowledge generally
5 available to one of ordinary skill in the art.(IN RE Jones, 958 F.2d 347, 351, 21 USPQ2d
6 1941, 1943-44 (Fed. Cir. 1992)). "Evidence of a suggestion, teaching, or motivation to
7 combine prior art references may flow, inter alia, from the references themselves, the
8 knowledge of one of ordinary skill in the art, or from the nature of the problem to be
9 solved. See Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. Although a reference need
10 not expressly teach that the disclosure contained therein should be combined with
11 another, see Motorola, Inc. v. Interdigital Tech. Corp., 121 F.3d 1461, 1472, 43 USPQ2d
12 1481, 1489 (Fed. Cir. 1997), the showing of combinability, in whatever form, must
13 nevertheless be "clear and particular." Dembiczak, 175 F.3d at 999, 50 USPQ2d at
14 1617." Winner International Royalty Corporation v. Ching-Rong Wang, 202 F.3d
15 1340(CAFC 2000).

16 The applicant respectfully requests the Examiner to withdraw the 103 rejections
17 in light of the argument, amendments and responses submitted.

18 **UNEXPECTED IMPROVED QUALITIES.** Your applicant respectfully comments on
19 the unexpected improved qualities inherent in this disclosure and particularly in contrast
20 to the disclosures of cited in the Examiner's Action. The recognition that the spring
21 function between the primary shaft and the lure shaft when the lure shaft is received into
22 the second barrel as a means of lessening the "throw off" of bait is seen as an unexpected
23 improvement over the cited art.

24 These stated features solves a concern of fisherman in lessening the likelihood
25 of loss of bate. "Factors including unexpected results, new features, solution of a

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1 different problem, novel properties, are all considerations in the determination of
2 obviousness in terms of 35 U.S.C. S 103. When such factors are described in the
3 specification they are weighed in determining, in the first instance, whether the prior art
4 presents a prima facie case of obviousness ... When such factors are brought out in
5 prosecution before the PTO, they are considered in determining whether a prima facie
6 case, if made based on the prior art, has been rebutted." *IN RE Wright*, 848 F.2d 1216,
7 1219, 6 USPQ2d 1959, 1962 (Fed. Cir. 1988), DISAPPROVED IN PART, *IN RE Dillon*,
8 919 F.2d 688, 16 USPQ2d 1897 (Fed. Cir. 1990), CERT. DENIED, *Dillon v. Manbeck*,
9 111 S. Ct. 1682 (1991), discussed in CHISUMS at S 5.04[6][d]; *Reading & Bates*
10 *Construction Co. v. Baker Energy Resources Corp.*, 748 F.2d 645, 223 USPQ 1168 (Fed.
11 Cir. 1984); *IN RE Merchant*, 575 F.2d 865, 869, 197 USPQ 785, 788 (CCPA 1978)
12 (stressing that there is no requirement that the "unexpected results relied upon for
13 patentability be recited in the CLAIMS". "It is entirely proper, nevertheless, in evaluating
14 nonobviousness, for a court to take to account advantages directly flowing from the
15 invention patented. After all, those advantages are the foundation of that 'commercial
16 success' which may be evidence of nonobviousness." *Preemption Devices, Inc. v.*
17 *Minnesota Mining & Mfg. Co.*, 732 F.2d 903, 907, 221 USPQ 841, 844 (Fed. Cir. 1984).

18 The applicant has set forth arguments and law for the basis upon which prior art
19 cited under 35 U.S.C. 103 should not result in a conclusion of obviousness for the present
20 invention as specified and claimed. The applicant has presented features of the present
21 invention which are not found within the claims of either reference patent. The applicant
22 has presented law and argument to support the contention that the rejection of claims,
23 under 35 U.S.C. 103 should be withdrawn and now respectfully requests the Examiner to
24 withdraw the rejections.

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SUMMARY OF AMENDMENTS AND REMARKS

The applicant has reviewed the Examiner's Action of March 3, 2004 and has addressed all objections and rejections disclosed therein. The applicant has submitted amended drawings and has amended the Specification to conform to the structure described in the Detailed Description and as seen by reference to the drawings as originally submitted with the application. The applicant has amended and cancelled claims. Accordingly, the applicant has made a good faith attempt to meet each objection and/or rejection as noted by the Examiner. The applicant has provided amended drawings, has amended the Specification, and has amended and cancelled claims. Accordingly your applicant requests the Examiner to withdraw the said objections and rejections and to allow the Drawings, Specification and claims as set forth and as amended.

Respectfully submitted,

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CERTIFICATE OF TRANSMISSION:

The undersigned hereby certifies that this correspondence is being facsimile transmitted to Examiner Bethany L. Griles, 703-305 1839, Art Unit 3643, of the Patent and Trademark Office Fax No. (703) 872 9306 on June 3, 2004.

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